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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,159	04/23/2001	Yacov Yacobi	MS1-777US	4122
22801	7590	08/24/2005	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201				LANIER, BENJAMIN E
ART UNIT		PAPER NUMBER		
2132				

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/841,159	YACOBI ET AL.
	Examiner Benjamin E Lanier	Art Unit 2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 July 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17, 56-61 and 70 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-17, 56-61 and 70 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 23 April 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed 11 July 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: An entity is capable of processing some license or other rights for a digital good. The specification discloses different types of entities (e.g., person, business, media player, or smart card), but is silent with respect to their processing abilities.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Response to Arguments***

2. Applicant's arguments filed 11 July 2005 have been fully considered but they are not persuasive. In response to Applicant's remarks regarding the amendments to the claims, the Examiner merely suggested in the interview date 20 June 2005 to amend the claims to further distinguish the unique entity from the Alattar reference and gave no indication whether specific limitations would overcome the rejections in view of Alattar.

3. Applicant's added limitation of "the fingerprint being a forensic entity identifier which is uniquely associated with a unique entity" is met by the Alattar reference because the fingerprint in Alattar is watermark combined with a random carrier signal ([0077]-[0082]), which is how Applicant defines their fingerprint (see claims 3 and 57). The amended limitation does not distinguish itself from Alattar because it does not add additional structure to the claimed fingerprint to separate itself from Alattar.

Art Unit: 2132

4. Applicant's second added limitation of "an entity is capable of processing some license or other rights for a digital good" is meet by Alattar's disclosure of the watermark key can include user or owner specific information (Page 20, [0244]) because Applicant's specification discloses that entities can be a person, business, media player, or smart card. The specification provides no additional information about the entities and their processing capabilities with respect to licenses or other rights for a digital good, and will therefore be treated as having equal processing capabilities with respect to licenses or other rights for a digital good. Therefore, because Alattar discloses that the entity could be the owner of the digital good, the limitation is meet.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 56, 70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. An entity is capable of processing some license or other rights for a digital good. The specification discloses different types of entities (e.g., person, business, media player, or smart card), but is silent with respect to their processing abilities.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-11, 13-17, 56-61, 70 are rejected, to the extent understood, under 35 U.S.C. 102(e) as being anticipated by Alattar, US 2002/0009208. Referring to claims 1, 3-6, 8, 16, 17, 56-59, 70, Alattar discloses digital watermark authentication method wherein the watermarking message is combined in one of a variety of ways (Page 6, [0082]) with a random carrier signal to create a key for the embedding of the watermark message into the host signal (Page 6, [0077]-[0082]), which meets the limitation of generating a fingerprint, the fingerprint being associated with a watermark, producing a pseudorandom watermark carrier that is independent of the watermark, combining or amalgamating the carrier and the watermark to generate the fingerprint, a marker configured to embed the watermark into a digital good, the fingerprint being a forensic entity identifier which uniquely associated with a unique entity, and embedding the watermark into a digital good without embedding the fingerprint. Alattar discloses that the watermark key can include user or owner specific information (Page 20, [0244]), which meets the limitation of an entity is capable of processing some license or other rights for a digital good.

Referring to claim 2, Alattar discloses that a hash can be generated from the image (Page 21, [0267]), which meets the limitation of producing a short fingerprint which is approximately equivalent to the fingerprint and is substantially smaller in scale than the fingerprint.

Referring to claims 7, 9, 10, 60, Alattar discloses that the watermark key can include user or owner specific information (Page 20, [0244]), which meets the limitation of the fingerprint is associated with a detection entity, and the fingerprint is uniquely associated with the watermark or the detection entity.

Referring to claim 11, Alattar discloses that the watermarking system can watermark video signals on a frame by frame basis (Page 11, [0141]), which meets the limitation of segmenting the digital good into multiple segments, repeating the obtaining, generating, and embedding for individual segments of the multiple segments, so that a segment has a segment-associated watermark embedded therein and a segment-associated fingerprint is associated with such segment-associated watermark.

Referring to claims 13, 61, Alattar discloses that the media could be images, audio, and video signals (Page 1, [0003]).

Referring to claim 14, Alattar discloses that watermarking functions are linear (Page 4, [0061]).

Referring to claim 15, Alattar discloses that the watermark detection process uses log base 10 calculations.

#### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alattar, US 2002/0009208, in view of Zhao, U.S. Patent No. 6,243,480. Referring to claim 12, Alattar discloses digital watermark authentication method wherein the watermarking message is combined in one of a variety of ways (Page 6, [0082]) with a random carrier signal to create a key for the embedding of the watermark message (Page 6, [0077]-[0082]), which meets the limitation of generating a fingerprint, the fingerprint being associated with a watermark, producing a pseudorandom watermark carrier that is independent of the watermark, combining or amalgamating the carrier and the watermark to generate the fingerprint. Alattar does not disclose that the fingerprints are associated with one or more detection entities. Zhao discloses a digital authentication system wherein when a user requests access to a digital document that user's identification is associated with the watermark embedded into the digital document distributed to the user (Col. 2, lines 20-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to trace illegal copies of digital documents back to the authorized user who originally received the document (Col. 3, lines 9-17).

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin E. Lanier

  
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